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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,165	05/10/1999	YASSIR K. ELLEY	SMY-013.01	8445

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EXAMINER

REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 07/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/310,165

Applicant(s)

ELLEY ET AL.

Examiner

Christopher A. Revak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-128 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>14-16, 19</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed May 27, 2004 have been fully considered but they are not persuasive.

It is argued by the applicant that the rejection of claims 101-128 complies with statutory requirements. The examiner respectfully disagrees. The examiner is not arguing that the claim is statutory, as per the section of the MPEP cited by the applicant, but it isn't established in the current claim language that the signal embodied in a carrier wave is tangibly embodied. The examiner contents that there is no positive recitation of hardware elements that make it statutory and nothing is present in the current claim language that satisfies the requirements of being useful, concrete, or tangibly embodied. The computer data signal embodied in a carrier wave representing a sequence of instructions that is broadly recited and based upon the word "representing" which is just computer software, it is not necessarily contained within hardware components as the claims are currently recited. The examiner is suggestive to the applicant that the claims rejected under 35 U.S.C. 101 be amended to be exclude the word "**when**" in the phrase "**when** executed by a processor" because the language of "**when** executed by a processor" is conditional and to be amended as "executed by a processor" is reciting that the computer data signal embodied in a carrier wave is implemented in hardware.

As per claims 1-128, it is argued by the applicant that Gasser et al fails to disclose of "the requesting principal presents to the resource server one or more chains of group credentials that prove the principal's membership in the nested group, so that the resource server is not required to retrieve group membership certificates and determine whether the requesting principal's identity is included in any of the retrieved certificates" and furthermore "the requesting principal is a member of the nested group is shifted from the resource server to the requesting principal." The examiner asserts that this feature is still disclosed by Gasser et al wherein a certificate is provided to the server whereby it contains certificate that the principal is a member of a group (see column 10, lines 35-39 & 64-65, column 11, lines 27-31, and column 21, lines 43-47).

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., server) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner additionally notes that the aspect of the resource server is not presently recited in independent claims 1,12,23, and 34.

3. Applicant's arguments filed on May 27, 2004 have been fully considered but they are not persuasive.

It is argued by the applicant that the rejection of claims 101-128 complies with statutory requirements. The examiner respectfully disagrees. The examiner is not arguing that the claim is statutory, as per the section of the MPEP cited by the applicant,

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but it isn't established in the current claim language that the signal embodied in a carrier wave is tangibly embodied. The examiner contends that there is no positive recitation of hardware elements that make it statutory and nothing is present in the current claim language that satisfies the requirements of being useful, concrete, or tangibly embodied. The computer data signal embodied in a carrier wave representing a sequence of instructions that is broadly recited and based upon the word "representing" which is just computer software, it is not necessarily contained within hardware components as the claims are currently recited. The examiner is suggestive to the applicant that the claims rejected under 35 U.S.C. 101 be amended to be exclude the word "**when**" in the phrase "**when** executed by a processor" because the language of "**when** executed by a processor" is conditional and to be amended as "executed by a processor" is reciting that the computer data signal embodied in a carrier wave is implemented in hardware.

Information Disclosure Statement

4. The information disclosure statements (IDS) submitted on December 29, 2003, February 6, 2004, March 31, 2004, and May 28, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 101-128 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is claimed of a computer data signal embodied in a carrier wave and representing a sequence of instructions that is directed towards non-statutory subject matter. The subject matter does not belong in a statutory classes and it is suggested by the examiner that the claims should be amended to be executed by a processor by deletion of the word "when" that precedes "executed".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-128 are rejected under 35 U.S.C. 102(b) as being anticipated by Gasser et al, U.S. Patent 5,220,604.

As per claims 1,23,45,59,73,87,101, and 115, it is disclosed by Gasser et al of method, system, and sequence of program sequences (data signal embodied on a carrier wave) for a user (presenter) located on a workstation (client) which makes a request (transmitted across a network) for access to resources to a server (recipient)

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containing (controlling) the system resources (col. 4, lines 26-29 & 55-64 and col. 21, lines 43-47 & 54-58). The teachings consist of program sequences (computer data signal embodied as carrier waves) that are to be executed by a CPU (processor)(col. 2, lines 58-60). Members are listed in a certificate (credentials) that which is nested groups that include subgroups (chains) that are certified (proven/validated entity membership)(col. 10, lines 19-55). If a requesting user (presenter), located in the group, is found in the resource's (services) is found in the access control list, then access is granted (authorized) by making the resources available to the members (col. 4, lines 50-54, col. 10, lines 50-55 & 61-65, and col. 21, lines 54-58).

As per claims 2,13,24,35,46,53,60,67,74,81,88,95,102,109,116, and 123, Gasser et al teaches of signed certificates (credentials) that verify (proof of) group membership (col. 11, lines 29-31).

As per claims 3,14,25,36,47,54,61,68,75,82,89,96,103,110,117, and 124, Gasser et al teaches of signed certificates that verify group membership (col. 11, lines 29-31).

As per claims 4,15,26,37,48,55,62,69,76,83,90,97,104,111,118, and 125, Gasser et al teaches of a group (membership) list that lists the members of a group (col. 11, lines 13-15 & 30-35).

As per claims 5,16,27,38,49,56,63,70,77,84,91,98,105,112,119, and 126, Gasser et al teaches of signed certificates (credentials) that verify (proof of) group membership (col. 11, lines 29-31). Gasser et al discloses of denying access to a first group which is a subgroup of a second group and only granting access to members of the second group who do not derive their membership in the second group through their

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membership in the first group (which is interpreted by the examiner as being non-membership)(see abstract, col. 24, lines 19-40). Gasser et al notes that groups may contain certificates which have been revoked and uncertified (indicating non-membership)(col. 11, lines 9-15).

As per claims 6,17,28,39,50,57,64,71,78,85,92,99,106,113,120, and 127, Gasser et al teaches of signed certificates that verify group membership (col. 11, lines 29-31). Gasser et al discloses of denying access to a first group which is a subgroup of a second group and only granting access to members of the second group who do not derive their membership in the second group through their membership in the first group (which is interpreted by the examiner as being non-membership)(see abstract, col. 24, lines 19-40). Gasser et al notes that groups may contain certificates which have been revoked and uncertified (indicating non-membership)(col. 11, lines 9-15).

As per claims 7,18,29,40,51,58,65,72,79,86,93,100,107,114,121, and 128, Gasser et al teaches of a group that which lists the members of a group (col. 11, lines 13-15 & 30-35). Gasser et al discloses of denying access to a first group which is a subgroup of a second group and only granting access to members of the second group who do not derive their membership in the second group through their membership in the first group (which is interpreted by the examiner as being non-membership)(see abstract, col. 24, lines 19-40). Gasser et al notes that groups may contain certificates which have been revoked and uncertified (indicating non-membership)(col. 11, lines 9-15).

As per claims 8,19,30, and 41, Gasser et al discloses of a user (presenter) located on a workstation (client) which makes a request (across a network) to a server (recipient) containing system resources (services)(col. 21, lines 43-47).

As per claims 9,20,31, and 42, Gasser et al discloses of a user (presenter) located on a workstation (client) which makes a request (across a network which is on-line) to a server (recipient) containing system resources (services)(col. 21, lines 43-47).

As per claims 10,21,32, and 43, Gasser et al discloses of a user (presenter) located on a workstation (client) which makes a request (across a network which is on-line) to a server (recipient) containing system resources (services)(col. 21, lines 43-47). Also disclosed is the use of determining if a certificate has been revoked (through means of a revocation server)(col. 11, lines 7-8).

As per claims 11,22,33, and 44, Gasser et al discloses of a user (presenter) located on a workstation (client) which makes a request (across a network) to a server (recipient) containing system resources (services)(col. 21, lines 43-47).

As per claims 12,34,52,66,80,94,108, and 122, it is disclosed by Gasser et al of method, system, and sequence of program sequences (data signal embodied on a carrier wave) for a user (presenter) located on a workstation (client) which makes a request (transmitted across a network) for access to resources to a server (recipient) containing (controlling) the system resources (col. 4, lines 26-29 & 55-64 and col. 21, lines 43-47 & 54-58). The teachings consist of program sequences (computer data signal embodied as carrier waves) that are to be executed by a CPU (processor)(col. 2, lines 58-60). Members are listed in a certificate (credentials) that which is nested groups

that include subgroups (chains) that are certified (proven/validated entity membership)(col. 10, lines 19-55). If a requesting user (presenter), located in the group, is found in the resource's (services) is found in the access control list, then access is granted (authorized) by making the resources available to the members (col. 4, lines 50-54, col. 10, lines 50-55 & 61-65, and col. 21, lines 54-58). Also taught by Gasser et al of a first group which is a subgroup of a second group and members of the second group who do not derive their membership in the second group through their membership in the first group (which is interpreted by the examiner as being non-membership)(col. 24, lines 19-40). Gasser et al notes that groups may contain certificates which have been revoked and uncertified (indicating non-membership)(col. 11, lines 9-15). The groups are only secure as the entity that controls modification access to the group list (col. 11, lines 13-15) and it is interpreted by the examiner that access is provided to resources if they are non-members of a group since it is non-secure as is recited by Gasser et al.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Balfanz et al, US 2004/0054899 discloses of group membership certificates.

Huitema et al, US 2003/0056093 discloses of group membership certificates.

Hanna et al, U.S. Patent 6,263,434 is a related teaching by the applicant.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 703-305-1843. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak
AU 2131

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July 10, 2004